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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/523,193	03/10/2000	Sean Matthew Doherty	169.1649	4782
5514	7590	11/29/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/523,193

Applicant(s)

DOHERTY, SEAN MATTHEW

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 14-24, 26 and 28-33 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 2-11, 14-24, 26 and 28-33 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 10 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 6 September 2005 have been fully considered but they are not persuasive. The arguments are addressed at para. 8-10 below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-11, 14-24, 26 and 28-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Beginning at para [0037], the published specification refers to *schedule 120* as if it were a memory element in the Fig 1 apparatus. But there is no such element in either Fig. 1 or the discussion of Fig. 1.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-11, 14-24, 26 and 28-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (US005848397A).
6. Marsh et al. teaches (independent claims 14, 26, 28, 29, 32 and 33, and dependent claims 2, 3, 30 and 31) a computer-executable method for scheduling items of information for display/presentation of an output device, an information processing apparatus for implementing said method, and a computer readable medium storing said method, the

method comprising: (a) scheduling items of information (*advertisements*) in accordance with values of priorities, said scheduling determining an order for displaying/presenting said items of information (col. 2 line 66 to col. 3 line 1 and col. 8 lines 63-66); (b) generating a user interrupt in response to a user interacting with the user interface (the user *clicking on a specified portion of the banner ad 601*, col. 7 line 53-55), when a *showcase ad 1001* was also being displayed (col. 7 line 66 to col. 8 line 4 and col. 8 lines 24-27 with Fig. 4); (c) clearing the main screen of the showcase ad items on information in response to the user interrupt (in order to provide the user with the requested *additional information*, col. 7 lines 55-57); (d) monitoring the time between keystrokes (col. 9 lines 28-31), which reads on estimating a time when the user will finish interacting with the user interface (the monitoring interval reads on the time estimate), said estimating being performed repeatedly until the user interaction with the user interface is finished; (e) rescheduling items of information for display/presentation in accordance with the values of the priorities (col. 4 lines 37-39); and (f) displaying the information as scheduled if the user is not interacting with the user interface at the estimated time.

7. Marsh et al. does not explicitly teach rescheduling items for each estimated time. It is noted that such a process would require a memory element to store said series of schedules. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted, first, that Marsh et al. produces the claimed result, displaying information rescheduled in accordance with priority values at the time of display, and second, that there is no clear disclosure in the instant application of a memory element to store said series of schedules. There is a reference to *schedule 120*, but the disclosure is neither complete nor clear (para. 3 above).
8. Applicant argues (pp. 15-16) that Marsh et al. does not teach “clearing the scheduled items of information”. It appears that applicant is interpreting the claim language to mean clearing the schedule. However, that is not what is claimed. Applicant has claimed clearing items of information. (The verb “clearing” has as its object the noun group “items of information”; “scheduled” is an adjective, not a noun, and therefore cannot be the object of a verb.) Marsh et al. teaches clearing any of the items of information that happen to be displayed, which reads on the claim.

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9. Applicant argues (pp. 16, first full para.) that logging the time of interruption does not read on estimating a time when the user will finish interacting with the user interface. The examiner acknowledges that the connection was not made very clear. Para. 6 above has been rewritten to more clearly cite monitoring the time between keystrokes as reading on estimating a time when the user will finish interacting with the user interface.
10. Applicant argues (pp. 16-17) that Marsh et al. does not teach or suggest performing repeated estimations "for each estimated time". The teaching is inherent (para. 7 above).
11. Marsh et al. also teaches claims 4, 7, 15 and 18 (col. 3 line 67), claims 5 and 16 (col. 15 line 36), claims 8 and 19 (col. 4 line 1), claims 6 and 17 (maximum number of exposures, col. 4 line 1, *per time to expiration*, col. 3 line 67, is a frequency), claims 8 and 19 (col. 4 line 1), claims 9 and 20 (col. 15 lines 54-56), claims 10, 11, 21 and 22 (col. 15 lines 56-62).
12. Marsh et al. also teaches claims 23 and 24 as the process described from col. 8 line 63 to col. 9 line 27, where the *highest priority* reads on a maximum priority.
13. Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (US005848397A). Marsh et al. does not teach selecting items that require minimum compile times. Because Ref2 teaches this would minimize restart delay, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Marsh et al. that items with minimum compile times be selected for reschedule after user interruptions.

Suggestion of Allowable Subject Matter

14. Marsh et al. neither teaches or suggests a memory device to store a schedule for each of a series of estimated times. Hence, if applicant can resolve the specification problem concerning the incomplete disclosure of *schedule 120*, and if this is in fact a memory device to store a schedule for each of a series of estimated times, it could be added as a limitation to the claims to overcome the instant rejection.
15. Applicant is cautioned that an allowance could not be considered until this or any other amendment were searched.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
19. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
21. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when

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applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words.

Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

22. Applicant may have after final arguments considered and amendments entered by filing an RCE.

23. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.


DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

26 November 2005